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Date: August 3, 2006	Phone Number	Fax Number
To: Examiner Bilgrami		(571) 273-8300
From: Kevin J. Zilka		

Docket No.:   NAIIP314/01.166.01   **App. No: 10/072,708**

Total Number of Pages Being Transmitted, Including Cover Sheet: 11

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Please deliver to Examiner Bilgrami.

Thank you,

Kevin J. Zilka

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PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) NAI1P314/01.166.01	
I hereby certify that this correspondence is being facsimile transmitted to the Commissioner for Patents, Alexandria, VA 22313-1450 to fax number (571) 273-8300; on August 3, 2006 Signature _____ Typed or printed name ___ April Skovmand	**Application Number** 10/072,708	**Filed** 02/05/2002
	First Named Inventor Luke David Jagger	
	Art Unit 2143	**Examiner** Bilgrami, Asghar H.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☑ attorney or agent of record.
Registration number   41,429

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature
Kevin J. Zilka
Typed or printed name

408-971-2573
Telephone number

August 3, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☑ *Total of ___1___ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REMARKS

The Examiner has rejected Claims 1-8, and 10-31 under 35 U.S.C. 103(a) as being unpatentable over Aronson et al. (U.S. Patent No. 6,654,787 B1) in view of Leeds (U.S. Patent No. 6,393,465 B2). Applicant respectfully disagrees with such rejection.

With respect to the independent claims, the Examiner has relied on Col. 4, lines 51-56, and Col. 5, lines 50-67 in Aronson, and the Abstract; Col. 3, lines 54-67; and Col. 4, lines 1-35 in Leeds to make a prior art showing of applicant's claimed "identifying an authority hosting the network address" (see the same or similar, but not necessarily identical language in the independent claims).

Applicant respectfully asserts that the excerpts from Leeds relied on by the Examiner only relate to a host computer associated with a sender of an electronic mail message (see Abstract and Col. 4, lines 66-67, specifically). In addition, Leeds discloses that "if a message has purportedly been relayed through a machine named mail.fromnowhere.com and the mail handling system has determined that such a machine does not actually exist, the confidence rating for the message should be increased." Clearly, determining a host computer/host name of a sender of e-mail or relay does not meet applicant's specific claim language, namely an "authority hosting the network address" (emphasis added), as claimed by applicant.

Further, applicant respectfully asserts that the excerpts from Aronson relied upon by the Examiner merely disclose that "[o]ther contemplated rule handling filter modules will filter e-mail based on: (1) word or letter frequency analysis; (2) IP source frequency analysis; (3) misspelling analysis (unwanted e-mail often contains misspelled words); (4) word or letter combination analysis; (5) technical or legal RFC822 header compliance; and (6) feature extraction & analysis (e.g., based on phone numbers, URL's, addresses, etc.)" (emphasis added). Clearly, filtering e-mail based on IP source frequency and feature extraction & analysis fails to even suggest "identifying an authority hosting the network address" (emphasis added), as claimed by applicant.

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In addition, the Examiner argued that "Ar[o]nson disclosed that the source header data from an incoming e-mail address (aardvark@aol.com) is analyzed by the spam probes." Further, the Examiner argued that '[t]he source header data includes the ISP (in this case "aol") hosting the spammer's network address (see col.4, lines 45-67).' Specifically, the excerpt from Aronson discloses that "[a] spam probe is an e-mail address selected to make its way onto as many spam mailing lists as possible." Aronson continues, teaching that "[i]t is also selected to appear high up on spammers' lists in order to receive spam mailings early in the mailing process" using an e-mail address such as "aardvark@aol.com." Clearly, the mere disclosure of using an e-mail address in a spam probe completely fails to even suggest "identifying an authority hosting the network address" (emphasis added), as claimed by applicant. In addition, it appears that the Examiner is improperly citing the domain portion of in an e-mail address (e.g. aol.com) to meet applicant's claimed "network address."

Still with respect to each of the independent claims, the Examiner has again relied on the Abstract; Col. 3, lines 54-67; and Col. 4, lines 1-35 in Leeds to make a prior art showing of applicant's claimed "generating a report containing the identified network address and hosting authority" (see the same or similar, but not necessarily identical language in the independent claims).

Applicant respectfully asserts that the only suggestion of a "report" in the excerpts relied on by the Examiner merely relates to "seed addresses [which] can alert an e-mail provider to potential mass mailings by reporting when mail is received for ghost or non-existent accounts." Clearly, alerting an e-mail provider when a e-mail is received for a seed address fails to even suggest "generating a report containing the identified network address and hosting authority" (emphasis added), as claimed by applicant.

Further, the Examiner argued that "Leeds also describes the similar process of identifying the host name of the spammer's address (please see col.4, lines 60-67 & col.5, lines 1-45)." Specifically, Leeds discloses that '[t]he fields for "Return Path:," "From:," and "Reply-To:" are highlighted as three of the fields which the present invention will parse from the message header.' As an example, Leeds teaches that "From:

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48941493@notarealaddress.com is broken down into a user id (48941493) and a host name (notarealaddress.com)" (emphasis added). Leeds continues, disclosing that 'a first level check is [used] to determine if the alleged sender identified by the "From:" or "Reply-To:" fields are valid.' Leeds discloses that the first level check 'includ[es]: (1) sending a message to the user identified by the "From:" or "Reply-To:" fields and examining whether the message can be successfully delivered, (2) using the UNIX "whois" command to determine if a site (or host) by that name actually exists, (3) using the UNIX "finger" command to identify if a user name exists at a verifiable host, (4) using the "vrfy" command when connected to a sendmail daemon to verify that a user exists at a particular site, and (5) using the UNIX "traceroute" command to make sure there is a valid route back to the specified host' (emphasis added). Clearly, performing a first level check including using whois, and traceroute to verify the host name from the "From:" and "Reply-To:" fields fails to even suggest "generating a report containing the identified network address and hosting authority" (emphasis added), as claimed by applicant.

Further, with respect to each of the independent claims, the Examiner has relied on Col. 4, lines 60-67; Col. 5, lines 1-44, and Col. 6, lines 52-65 in Leeds to make a prior art showing of applicant's claimed technique "wherein identifying the hosting authority comprises identifying an owner of a network domain" (see the same or similar, but not necessarily identical language in the independent claims).

Applicant respectfully asserts that the excerpts from Leeds relied upon by the Examiner merely disclose 'a first level check is to determine if the alleged sender identified by the "From:" or "Reply-To:" fields are valid' (emphasis added). In addition, Leeds discloses 'using the UNIX "whois" command to determine if a site (or host) by that name actually exists' (emphasis added). Clearly, using whois to perform a first level check to ensure the host actually exists for the alleged sender in the "From:" or "Reply-To:" fields fails to even suggest a technique "wherein identifying the hosting authority comprises identifying an owner of a network domain" (emphasis added), as claimed by applicant. Applicant respectfully asserts that merely ensuring that a host actually exists fails to even suggest "identifying an owner of a network domain," as claimed by applicant.

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To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above. Thus, a notice of allowance or a proper prior art showing of all of the claim limitations, in the context of the remaining elements, is respectfully requested.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. Just by way of example, with respect to Claim 2 et al., the Examiner has relied on Col. 4, lines 36-67; Col. 5, lines 1-44; and Col. 8, lines 34-57 in Leeds to make a prior art showing of applicant's claimed "transmitting the generated report to the identified hosting authority." Applicant respectfully asserts that the only mention of any sort of report in such excerpts from Leeds simply teaches that "addresses could be watched for incoming junk e-mail and a notification from the authentication server could then be broadcast to users indicating that mail with the subject of "XYZ" is junk e-mail" (see, specifically, Col. 8, lines 47-50). Clearly, such notification sent to users does not meet applicant's claimed "transmitting the generated report to the identified hosting authority" (emphasis added).

With respect to Claim 4, the Examiner has relied on Col. 4, lines 57-67; Col. 5, lines 1-8; and Col. 5, lines 50-67 in Aronson to make a prior art showing of applicant's claimed technique "wherein identifying a URL comprises comparing text within the electronic message to a database of words to identify the URL." After careful review of the excerpts

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relied on by the Examiner, applicant notes that the only URL disclosed in Aronson relates to filtering e-mail based on "feature extraction & analysis (e.g.,...URL's...)" (see Col. 5, lines 63-64). However, Aronson does not teach how such URL is identified, whereas applicant specifically claims "identifying a URL [by] comparing text within the electronic message to a database of words to identify the URL." Applicant further notes that Aronson only teaches that spam may be filtered "based on a specific keyword search," and that therefore the keywords are used to identify spam, but not that a database of words is utilized to "identify the URL" in the manner claimed by applicant (emphasis added).

With respect to Claim 12, the Examiner has relied on Col. 5, lines 38-44 in Leeds to make a prior art showing of applicant's claimed technique including "at least temporarily saving the report and transmitting the report to the identified hosting authority at the end of a specified period." Applicant respectfully asserts that such excerpt only relates to "sending a verification address...within a period of time." Clearly, sending a verification message to determine if a user is actually associated with the sender of e-mail does not meet applicant's claimed report, let alone "transmitting the report to the identified hosting authority at the end of a specified period" (emphasis added).

Again, since at least the third element of the *prima facie* case of obviousness has not been met, a notice of allowance or a proper prior art showing of all of the claim limitations, in the context of the remaining elements, is respectfully requested.